

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicants thank the Examiner for carefully considering this application.

Disposition of Claims

Claims 1-8, 10-15, 17, and 20-23 are pending in the present patent application. Claims 1, 2, 13, 14, and 15 are independent. The remaining claims depend, either directly or indirectly, on claims 1, 2, 13, 14, and 15.

Claim Amendments

Claims 1, 2, and 15 are amended for clarification. Applicants respectfully assert that no new matter is added by way of these amendments as support for these amendments may be found, for example, in paragraph [0022] of the published application, in the corresponding figures, and in the originally filed claims.

Rejections under 35 U.S.C. § 101

Claims 1, 2-8, 10-12, 15, 17, 20, 21, and 23 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Examiner contends that the pending claims merely recite an apparatus in terms of software and data. *See* Action at page 3. By way of this reply, independent claims 1, 2, and 15 are amended to recite the existence and use of a processor (*i.e.*, a hardware element). Accordingly, Applicants respectfully assert that amended independent claims 1, 2, and 15, and dependent claims 3-8, 10-12, 17, 20, 21, and 23 satisfy all requirements of 35 U.S.C. § 101, and withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. § 102

Claims 1-8, 10-15, 17, and 20-23 stand rejected under 35 U.S.C. § 102(b) based upon a public use or sale of the invention. Specifically, the Examiner contends that Applicants declared the invention to be implemented no later than February 22, 2000, which is more than 1 year prior to the effective filing date of the present application. *See* Action at pages 2 and 3. For the reasons set forth below, this rejection is respectfully traversed.

The public use bar under 35 U.S.C. § 102(b) arises where the invention is in public use before the critical date and is ready for patenting. *Invitrogen Corp. v. Biocrest Manufacturing L.P.*, 424 F.3d 1374, 76 USPQ2d 1741 (Fed. Cir. 2005). *See* MPEP § 2133.03(a). Further, an impermissible sale has occurred if there was a definite sale, or offer to sell, more than 1 year before the effective filing date of the U.S. application and the subject matter of the sale, or offer to sell, fully anticipated the claimed invention or would have rendered the claimed invention obvious by its addition to the prior art. *Ferag AG v. Quipp, Inc.*, 45 F.3d 1562, 1565, 33 USPQ2d 1512, 1514 (Fed. Cir. 1995). The on-sale bar of 35 U.S.C. § 102(b) is triggered if the invention is both (1) the subject of a commercial offer for sale not primarily for experimental purposes and (2) ready for patenting. *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 67, 48 USPQ2d 1641, 1646-47 (1998). *See* MPEP § 2133.03(b).

Although Applicants declared in the prior Office Action response dated October 6, 2008, by way of a Declaration pursuant to 37 CFR § 1.131 (“Declaration”), that the claimed invention was implemented no later than February 22, 2000, the implementation details supporting the Declaration were ***not*** publicly available more than 1 year prior to April 12, 2001 (*i.e.*, the effective filing date of the present application). The implementation details provided

remained internal to the company and were not disseminated. Moreover, Applicants respectfully assert that such implementation of the claimed invention does not equal public use of the claimed invention, a sale of the claimed invention, and/or an offer to sell the claimed invention. In fact, contrary to the Examiner's contentions, Applicants respectfully assert that there was no public use of the claimed invention, as defined in MPEP § 2133.03(a), more than 1 year prior to the effective filing date of the present application.

Applicants also respectfully assert that there was neither a sale of the claimed invention nor an offer to sell the claimed invention, as defined in MPEP § 2133.03(b), more than 1 year prior to the effective filing date of the present application. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09469/108001; 59.0044).

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Respectfully submitted,

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